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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,696	01/04/2002	Chao-Chi Huang	PAT-1422	5668

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Raymond Sun
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Tustin, CA 92782

EXAMINER

SAID, MANSOUR M

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,696

Applicant(s)

HUANG ET AL.

Examiner

MANSOUR M SAID

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-12, 14-17, 22 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-12, 14-17, 22 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

- 1. This office action is in respond to amendment filed on April 16, 2004, and five new claims (27-31) have been added.**

Claim Rejections - 35 USC § 103

- 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claim 1-4, 7-12, 14-17, 22, 26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (US 2002/0021291 A1) in view of Colgan et al. (6,529,189 B1; hereinafter referred to as Colgan).**

As to claim 1, Cook teaches a touch control pen (stylus, (figures 1-2 & 4, (10)) for a PDA (abstract; page 2, paragraph 0018, lines 1-20 and page 2, paragraph 0021, lines 1-16) comprising: a pen holder (cylindrical housing, (figures 1-2 & 4, (12)) (page 2, paragraph 0018, lines 1-8); having a front tip (tip, figure 1-4, (18)) (column 2, paragraph 0020, lines 3-4) a light source (LED, (figures 2& 4, (46 & 56)) for generating light (figures 1-4; abstract, page 2 paragraph 0018, lines 1-20; page 2, paragraph 0022, lines 1-11; page 2, paragraph 0023, lines 1-11; page 2, paragraph 0024 through paragraph 0026, lines 6).

Cook does not expressly teach that a stylus separate from the penholder and attached to the front tip of the penholder, the stylus incorporating a light source.

However, Colgan teaches a stylus separate from the pen holder (as clearly shows on figure 2, the stylus tip is separated from top part of the device) (figures 1-2 and column 10-40) and attached to the front tip (stylus tip, (figure 1, (16)) of the pen holder (column 3, lines 10-35), the stylus incorporating a light source (led, (figure 2, (18)) (column 3, lines 10-15 and column 3, lines 35-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Colgan's stylus with an infrared light emitting diode into Cook's system so that can be actuated by the user during the course of pointing the stylus at a touch screen location (abstract).

As to claim 2, Cook teaches wherein the light source (LED, (figures 2& 4, (46 & 56)) is a light emitting diode (LED) (abstract; page 2, paragraph 0022, lines 1-11 and page 2, paragraph 0023, lines 1-11).

As to claim 3, Cook teaches wherein the pen holder (cylindrical housing, (figures 1-2 & 4, (12)) has a housing that retains a circuit (cylindrical circuit means, (figure 2, (48)) and at least one battery (cylindrical battery, (figures 2 & 4, (34)) that is electrically coupled to the circuit (figures 1-4; abstract; page 2, paragraph 0021, lines 1-19; page 2, paragraph 0022, lines 1-11; page 2, paragraph 0023, lines 1-11 and page 3, claim 1).

As to claim 4, Cook teaches a pen lid (interchangeable head rotatable head, (figures 1-2 & 4, (14)) that is secured to a rear end of the pen holder (cylindrical housing, (figures 1-2 & 4, (12)) (abstract; page 2, paragraph 0019, lines 1-10 and page 2, paragraph 0021, lines 1-16).

As to claim 7, cook teaches wherein the light source (LED, (figures 2& 4, (46 & 56))) is coupled to the circuit (cylindrical circuit means, (figure 2, (48))) (abstract; page 2, paragraph 0023, lines 1-11 and page 3, claim 1).

As to claim 8, Cook teaches wherein the pen lid (interchangeable head or rotatable head, (figures 1-2 & 4, (14))) includes an insulation piece (metallic sleeve, (figures 2 & 4, (45))) that abuts the at least one battery (battery cathode, (figure 2 & 4, (36))) to ensure that the at least one battery contacts the circuit (cylindrical circuit means, (figure 2, (48))) to complete an electrical connection (figures 1-4; abstract; page 2, paragraph 0022, lines 1-11 and page 3, claims 1 & 7).

As to claim 9, Cook teaches a switch (figure 4, (54)) coupled to the circuit for controlling the turning on and off of the light source (LED, (figures 2& 4, (46 & 56))) (abstract; page 1, paragraph 0017, lines 1-5; page 2, paragraph 0024, lines 1-16; page 4, claims 26 & 30).

As to claim 10, Cook teaches wherein the stylus is made from a different material as the light source (LED, (figures 2& 4, (46 & 56))) (figures 1-4; page 2, paragraph 0019, lines 1-20; page 3, paragraph 0027, lines 27-39; page 3, paragraph 0028, lines 1-5 and page 3, paragraph 0029, lines 1-15).

As to claim 11, Cook teaches wherein the stylus (stylus, (figures 1-2 & 4, (10))) is made of plastic. (polymeric) (page 2, paragraph 0019, lines 1-20 and page 2, paragraph 0020, lines – 19).

As to claim 12, Cook teaches wherein the stylus (stylus, (figures 1-2 & 4, (10))) is made of an alloy (combined with metallic oxides) (page 2, paragraph 0019, lines 1-20).

As to claim 14, Cook teaches means for securing the pen holder (cylindrical housing, (figures 1-2 & 4, (12))) to a PDA (figures 1-4; abstract; page 1, paragraph 0009, lines 1-2; page 2,

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paragraph 0019, lines 1-6; page 2, paragraph 0019, lines 1-6; paragraph 0021, lines 1-16; and page 2, paragraph 0024, lines 11-15).

As to claim 15, cook teaches a PDA assembly, comprising a PDA (abstract; paragraph 0009, lines 1-2; page 2, paragraph 0019, lines 1-6; page 2, paragraph 0019, lines 1-6; paragraph 0021, lines 1-16; and page 2, paragraph 0024, lines 11-15); and a touch control pen (stylus, (figures 1-2 & 4, (10))), comprising: a pen holder (cylindrical housing, (figures 1-2 & 4, (12))) (abstract; page 2, paragraph 0018, lines 1-20 and page 2, paragraph 0021, lines 1-16); and a light source (LED, (figures 2 & 4, (46 & 56))) coupled to the pen holder (cylindrical housing, (figures 1-2 & 4, (12))) for generating light coupled to the pen holder for generating light (figures 1-4; abstract, page 2 paragraph 0018, lines 1-20; page 2, paragraph 0022, lines 1-11; page 2, paragraph 0023, lines 1-11; page 2, paragraph 0024 through paragraph 0026, lines 6).

As to claim 16, Cook teaches wherein the pen holder (cylindrical housing, (figures 1-2 & 4, (12))) has a housing that retains a circuit (cylindrical circuit means, (figure 2, (48))) and at least one battery (cylindrical battery, (figures 2 & 4, (34))) that is electrically coupled to the circuit (figures 1-4; abstract; page 2, paragraph 0021, lines 1-19; page 2, paragraph 0022, lines 1-11; page 2, paragraph 0023, lines 1-11 and page 3, claim 1).

As to claim 17, Cook teaches a pen lid (interchangeable head rotatable head, (figures 1-2 & 4, (14))) that is secured to a rear end of the pen holder (cylindrical housing, (figures 1-2 & 4, (12))) (abstract; page 2, paragraph 0019, lines 1-10 and page 2, paragraph 0021, lines 1-16).

As to claim 22, Cook teaches (stylus, (figures 1-2 & 4, (10))) for a PDA (abstract; page 2, paragraph 0018, lines 1-20 and page 2, paragraph 0021, lines 1-16), comprising: a pen holder a pen holder (cylindrical housing, (figures 1-2 & 4, (12))) (abstract; page 2, paragraph 0018, lines

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1-20 and page 2, paragraph 0021, lines 1-16; and means for securing the pen holder (cylindrical housing, (figures 1-2 & 4, (12))) to a portion of a PDA (page 1, paragraph 0009, lines 1-2 and page 2, paragraph 0018, lines 1-1-6).

As to claim 26, Cook teaches further comprising a light source (LED, (figures 2& 4, (46 & 56)) coupled to the pen holder (cylindrical housing, (figures 1-2 & 4, (12))) for generating light (figures 1-4; abstract, page 2 paragraph 0018, lines 1-20; page 2, paragraph 0022, lines 1-11; page 2, paragraph 0023, lines 1-11; page 2, paragraph 0024 through paragraph 0026, lines 6).

As to claims 29-31, Cook fairly teaches wherein the pen holder further includes a toothed gripping surface (toothed shape gripping) (rotatable head, (figures 1-2 & 4, (14)) (column 2, paragraph 0019, lines 1-4).

4. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Colgan as applied to claims 14-15 above, and further in view of Searby et al. (4,580,007; hereinafter referred to as Searby).

As to claims 27-28, Cook teaches all claimed limitation except that having a piece of magnet one end of the penholder.

However, Searby teaches that a stylus having a piece of magnet one end of the pen holder (housing) (figures 1-2 and column 1, lines 55-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Searby's stylus having a magnet within the housing into Cook's device so as to constraining the stylus so as to limit its movement outwards.

Response to Arguments

5. Applicant's arguments with respect to claims 1-4, 7-12, 14-17, 22 and 27-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS OFFICE ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mansour M. Said** whose telephone number is **(703) 306-5411**.

The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Friday from 8:30 a.m. to 5:00 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Shalwala Bipin**, can be reached at **(703) 305-4938**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:


(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer service Office whose telephone number is (703) 306-0377.

June 28, 2004

Mansour M. Said

A handwritten signature in black ink, appearing to read 'Vijay Shankar', written in a cursive style.

**VIJAY SHANKAR
PRIMARY EXAMINER**